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PATENT, TRADEMARK, COPYRIGHT
AND UNFAIR COMPETITION LAW
AND RELATED LITIGATION

EDMUND P. WOOD 1923-1988
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DATE: June 3, 2004

RE: Serial No. 09/802,646; Filed:
March 9, 2001; For: Apparatus
and Method for
Extruding Single-Component
Liquid Strands into Multi-
Component Filaments; Applicant:
Martin A. Allen; Conf. No. 8531

TO: Examiner Joseph S. Del Sole
Group Art Unit 1722

FROM: Kevin G. Rooney

FAX NO.: 703-872-9306

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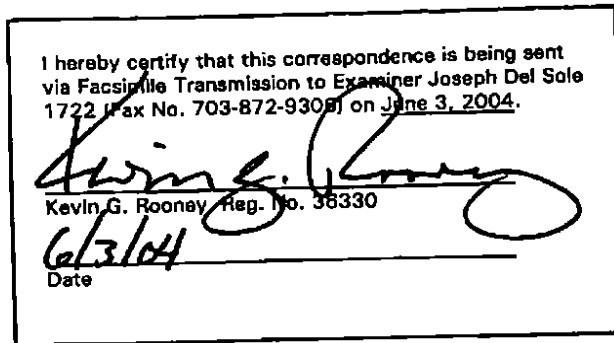
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Applicant: Martin A. Allen
Serial No.: 09/802,646
Filed: March 9, 2001
Group Art Unit: 1722
Examiner: Joseph S. Del Sole
Confirmation No.: 8531
Title: APPARATUS AND METHOD FOR EXTRUDING SINGLE-
COMPONENT LIQUID STRANDS INTO MULTI-COMPONENT
FILAMENTS
Attorney Docket: NOR-989

Cincinnati, Ohio 45202

June 3, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

AFTER FINAL RESPONSE

This responds to the Office Action mailed on March 3, 2004 and follows up on a telephone conversation Applicant's undersigned counsel held with Examiner Del Sole held on June 3, 2004. During that telephone conversation, Applicant's counsel argued that the Page reference failed to anticipate claims 5, 10

-1-

and 11 and the Examiner suggested that such arguments be presented in writing. Therefore, the present response is being submitted in an effort to expedite the issuance of this patent application. Applicant respectfully solicits Notice of Allowance for the reasons given below.

The Examiner has rejected claims 5, 10 and 11, the only pending claims in the present application, under 35 U.S.C. § 102(b) as being allegedly anticipated by Page, U.S. Patent No. 3,981,650. The Examiner states that the recitation, "the first and second strands combining together immediately after extrusion to form the plurality of multi-component filaments having a cross-sectional configuration combining the first and second types of liquid material" is a process limitation and, further, that reference to "multi-component" is also a process limitation. The Examiner alleges that "intended use has been continuously held not to be germane to determining the patentability of the apparatus." Applicant submits that it is improper for the Examiner to completely ignore functional limitations in a claim. At the very least, the function or functions recited in a claim must be inherent in the structure cited by the Examiner in the prior art. That is, the prior art structure must at least be capable of performing the function. Even then, however, the Examiner has the initial burden of establishing inherency:

We are mindful that there is a line of cases represented by *In re Swinehart*, . . . which indicates that where an examiner has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, the examiner possesses the authority to require an applicant to prove that the subject

matter shown to be in the prior art does not possess the characteristic relied on. Nevertheless, before an applicant can be put to this burdensome task, the examiner must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art. (*Ex parte Skinner*, 2 USPQ2d 1788, 1789 (B.P.A.I. 1986).

This issue was also taken up by the Court of Customs and Patent Appeals in *In re Attwood*, 148 USPQ 203 (CCPA 1966). The Court recognized that claimed "use limitations" or functions are "functional expressions which must be given weight". The Court of Customs and Patent Appeals has decided *In re Angstadt and Griffin*, 190 USPQ 214 (CCPA 1976) and *In re Geerdes*, 180 USPQ 789 (CCPA 1974). In the *In re Geerdes* case, the Court pointed out that:

every limitation in the claim must be given effect rather than considering one in isolation from the others (Court's emphasis), at page 791.

Similarly, the Court stated in *In re Angstadt and Griffin* at page 217:

We note at the outset that the claim limitation "to form...hydroperoxides" must be given effect since we must give effect to all claim limitations. See *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789 (CCPA 1974); *In re Wilder*, 57 CCPA 1314, 429 F.2d 447, 166 USPQ 545 (1970). Furthermore, the use of functional language is sanctioned specifically by the third paragraph of section 112. (Court's emphasis).

In *Wentworth v. Schena*, 219 USPQ 1042, 1044 (Patent and Trademark Office, Board of Patent Interferences 1983) when the Board was confronted with an apparatus claim containing the language "for supplying catalyst

to a blower of a liquid fuel combustion device", it held that such a functional recitation must not be ignored citing *Kropa v. Robie*, 187 F.2d 150, 88 USPQ 478 (CCPA 1951); *In re Attwood*, 354 F.2d 365, 148 USPQ 203 (CCPA 1966); *Ex parte Varga*, 189 USPQ 204 (Pat.Bd.App. 1973).

In the present case, the Page reference discloses neither the recited function of the claimed structure nor the claimed structure itself as will be further discussed below. The Page reference only discusses dispensing monofilaments, albeit with each filament being formed from a different polymer, and does not disclose or suggest, or even inherently allow the ability to, discharge "multi-component filaments" as such filaments are understood by those of ordinary skill in the art. For this reason alone, the Page reference fails to anticipate the claim language.

In addition, however, the Examiner has alleged that the Page reference discloses the recitation in claim 5 which states "each second outlet tangentially meeting with a corresponding one of said first liquid outlets at said external surface." The external surface referred to in claim 5 is exemplified in Fig. 5 of the present application and the corresponding external surface is shown in Fig. 4 of the Page reference. Page 13, lines 17 and 18 of the present application specifically refer to the structure shown in Fig. 5 as "first and second outlets 76, 78. . . shown to tangentially meet." Thus, the meaning of the claim language with regard to "tangentially meeting" first and second liquid outlets is entirely clear from reading the specification in conjunction with Fig. 5 of the present application. Fig.

5 shows first and second outlets 76, 78 with their respective edges slightly touching in a tangential manner. Applicant is allowed by law to be his own lexicographer when drafting a patent application as long as the chosen terminology does not defy logic or reason to one of ordinary skill. In the present situation, while the term "tangential" as used in the context of the present application may not meet the strict geometrical definition of a "tangent,"¹ the meaning of "tangential" is "of, relating to, or of the nature of a tangent." (Webster's Ninth New Collegiate Dictionary, 1991). Based on the drawing shown in Fig. 5, while the two orifices 76, 78 may not meet exactly at a single "point" as that term is used in a geometrical sense, they are certainly meeting in a "tangential" manner or a manner which is in the "nature of a tangent." On the other hand, Page's orifices 22c, 23c are clearly spaced a significant distance from each other. In no way can these orifices 22c, 23c be considered as "tangentially meeting" at the outer surface. This structural difference, combined with the resulting functional difference, as recited in independent claim 5 clearly sets forth a patentable invention over the structure and function disclosed by the Page reference. Dependent claims 10 and 11 are respectfully submitted to be allowable for at least the same reasons.

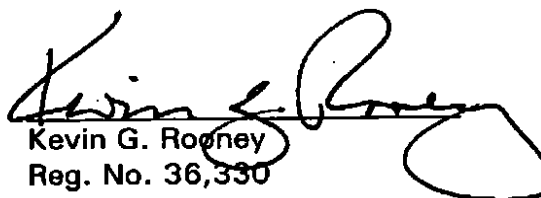
¹ Webster's Ninth New Collegiate Dictionary 1991 defines "tangent" to mean "meeting a curve or surface in a single point if a sufficiently small interval is considered."

If there is any additional matter in need of discussion upon review of this application, the Examiner is invited to contact Applicants' undersigned counsel by telephone to expedite issuance of this application.

Applicant believes that no other fees are due in connection with this response. However, if such petition is due or any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.



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